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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,468	12/12/2003	David A. Franklin	085314.015	9594
7590	03/22/2005		EXAMINER	
Jeffrey S. Whittle Bracewell & Patterson, LLP P.O. Box 61389 Houston, TX 77208-1389			FISHMAN, MARINA	
			ART UNIT	PAPER NUMBER
			2832	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,468	FRANKLIN ET AL. <i>SM</i>	
	Examiner	Art Unit	
	Marina Fishman	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4 and 5 is/are allowed.
- 6) Claim(s) 1-3,6-13,16-30 is/are rejected.
- 7) Claim(s) 14 and 15 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

General status

1. This is a Final Action on the Merits. Claims 1 - 30 are pending in the case and are being examined.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 – 20 and 26 – 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of the claim 11 "an operation counter assembly **adapted to be** positioned on a circuit interrupting apparatus..." suggests that only "an operation counter assembly" is being positively claimed and the "circuit interrupting assembly" is not being positively claimed. For purposes of examination, the claim 11 interpreted to include the circuit interrupting assembly along with all the components. Similar recitation is present in claims 26-30.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 21, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicolai et al. [US 6,300,585].

The method steps of the 21, 29 and 30 are necessitated by the device structure and disclosed by Nicolai et al. [Figure 1 – 13]. Nicolai et al. disclose an operation counter assembly including an operation counter housing [60, 50] containing an operation counter [10] and an operation counter actuating switch [34] and having an operation counter housing back side opening adapted to interface with a reset plunger [30,32] protruding through a main housing body outer surface of the circuit interrupting apparatus and an operation counter housing front side opening for allowing passage of the reset plunger through the operation counter housing; installing an operation counter actuating switch actuator to the reset plunger; and fastening the operation counter housing to the main housing body of the circuit interrupting apparatus.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 - 3, 6 - 13, and 16 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. [US 5,861,595] in view of Nicolai et al. [US 6,300,585].

- a main housing [34] having a main housing body including a main housing body outer surface and a longitudinal axis [35];

- a sleeve [36] including a main sleeve body having a sleeve main body outer surface and coaxially mounted within the main housing so as to be slidable between an extended position and a retracted position, a spring assembly [38] for biasing the main sleeve body from between the extended position toward the retracted position, and a reset plunger opening positioned in a medial portion of the main sleeve body [Column 4, lines 45 – 55];
- a shunting circuit assembly [74] having a ring engaging terminal [40] adapted to electrically connect to a ring-like conducting part of a circuit isolating device and a hook engaging terminal [68] adapted to electrically connect to a hook-like conducting part of a circuit isolating device, a shunting circuit segment connected between the ring engaging terminal and the hook engaging terminal and positioned within the housing and sleeve to interrupt an electrical connection between the ring-like conducting part and hook-like conducting part responsive to movement of the sleeve from the retracted position to the extended position [Column 5, lines 48 – 60];
- a reset plunger assembly [76] including a reset plunger and connected to a medial portion of the main housing body, adapted to extend at least portions of the reset plunger through the reset plunger opening in the medial portion of the main sleeve body when in a non-reset and biased inward lock position to releasably lock the sleeve in the

extended position so as to obtain and maintain an electrical clearance between the ring engaging terminal and the hook engaging terminal when the ring engaging terminal and the hook engaging terminal engage a circuit isolating device and when the main sleeve body is positioned in the extended position, and adapted to reset outwardly responsive to outwardly biased pressure by a user and outward pressure from the main sleeve outer surface when the sleeve main body is in an at least partially retracted position [Figure 3; Columns 5 – 7].

Regarding Claims 1, 11, 21, 22, 23, 26 and 28, Wood et al. disclose the instant claimed invention except for an operation counter assembly with an operation counter. Nicolai et al. disclose an operation counter assembly with an operation counter [10; Abstract]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an operation counter assembly with an operation counter in Wood et al., as suggested by Nicolai et al., in order to improve scheduling of maintenance and inspection [Column 2, lines 28 – 32].

Regarding Claims 2, 3, 6 – 10, 12, 13, 16-20, 24, 25 and 27, Nicolai et al. disclose the operation counter assembly with the operation counter [Figures 1 – 14] having a rotational counter incrementor [112, Figure 13] to increment a count of the operation counter; a roll pin [Figure 13] connected to the reset plunger and click-over lever [114]; a counter incrementor switch [34; Column 3, lines 47 +, and Column 4, lines 25 – 31].

Regarding Claim 22, the method steps are necessitated by the device structure and disclosed by Wood et al. in view of Nicolai et al.

Allowable Subject Matter

7. Claims 4, 5 are allowed.
8. Claims 14 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed January 21, 2005 have been fully considered but they are not persuasive.
10. Applicant has argued that Examiner has failed to meet prima facie case of obviousness. Examiner respectfully disagrees. Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. [*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)]. In this case, as indicated in the body of the rejection, the motivation to combine Nicolai et al. with Wood et al. is provided by Nicolai et al.

Applicant has also argued that Nicolai et al. fail to suggest the operational counter adapted to be connected to a portion of the housing body. Examiner respectfully disagrees. Nicolai et al. reference specifically discloses that the operations counter is

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for a circuit interrupter (see title and abstract). Also, the load break tool described by the Nicolai et al. reference is equal to the body of the circuit interrupter of Wood et al. or that of the present invention. The counter is connected to the body of the interrupter along with the reset plunger, and the trailer portion [14] of Nicolai et al. is associated with a pin of a plunger. It should be noted that the counter counts the number of interruptions, and that can be associated with the operation of the reset plunger.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is 571-272-1991. The examiner can normally be reached on 7-5 M-T.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Fishman
March 7, 2005

[Handwritten Signature]
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MARINA FISHMAN
PRIMARY EXAMINER
GROUP 210